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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,235	05/29/2001	Larry Richard Robinson	8569	5928
27752	7590	07/28/2005	EXAMINER	
THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			HUI, SAN MING R	
			ART UNIT	PAPER NUMBER
			1617	
DATE MAILED: 07/28/2005				

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**GROUP 1600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/867,235

Filing Date: May 29, 2001

Appellant(s): ROBINSON ET AL.

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Juliet A. Jones  
The Proctor and Gamble Company  
Sharon Woods Technical Center  
11511 Reed Hartman Highway  
Cincinnati, OH 45241  
For Appellant

**EXAMINER'S ANSWER**

*SL*

*5010*

This is in response to the appeal brief filed May 13, 2005.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 27-31 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

EP 0,908,175

## Rouquet

4-1999

Stedman's Medical Dictionary, 27<sup>th</sup> Edition, 2002-2004 Thomson PDR, "sunscreen".

Mosby's Medical Dictionary, 4<sup>th</sup> Edition, 1994 Mosby-Year Book, Inc, "erythema"

### **(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

## ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by

Rouquet et al. (EP 0908175) as evidenced by Stedman's and Mosby's Medical Dictionary.

Rouquet et al. disclose stable topical compositions containing solid elastomeric organopolysiloxane and spherical particles. Exemplified is a water-in-oil make-up foundation comprising, dimethicone copolyol (silicone oil), cyclomethicone (silicone oil), octyl methoxycinnamate (oil-soluble sunscreen anti-inflammatory agent), and KSG-16 (crosslinked silicone elastomer), wherein foundations are applied to the skin. Thus, Rouquet et al. and the instant invention both teach a method of applying to the skin a composition comprising a water-in-oil emulsion comprising a silicone oil, a crosslinked

silicone elastomer, and a skin care active, all of which are in the oil-phase. See pages 10-11.

Stedman's Medical Dictionary, 27<sup>th</sup> Edition defines a sunscreen that protects the skin from ultraviolet induced erythema and Mosby's Medical Dictionary, 4<sup>th</sup> Edition defines erythema as redness or inflammation of the skin or mucous membranes.

The claims are directed to a method of applying a composition comprising oil-soluble skin care active, silicone oil, and silicone elastomer to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01). The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components' as instantly claimed, which would inherently enhance the delivery of the oil soluble skin care active and regulate the condition of the skin and enhance the delivery of the same, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

#### **(11) Response to Argument**

Appellant's arguments in pages 3-4 in the brief filed May 13, 2005 averring the cited reference's failure to anticipate all elements of Appellant's claimed invention are

not convincing. Although Rouquet et al. does not expressly teach the composition containing oil-soluble antioxidants or oil-soluble vitamin B3 compounds, it does teach the composition having octyl methoxycinnamate, which is an oil-soluble anti-inflammatory agent. Therefore, the teachings of Rouquet et al. read on the claims as herein recited.

Appellant's arguments in pages 4-5 in the brief filed May 13, 2005 averring Rouquet et al.'s failure to anticipate the claims herein recited since Rouquet disclosing a genus of broad active compounds, while the instant claims recite a sub-genus of actives are not convincing. As discussed above, Rouquet et al. teaches a specific anti-inflammatory agent, octyl methoxycinnamate, useful in the composition of Rouquet. Therefore, Rouquet et al. actually teaches the specie of the active recited.

Appellant's arguments in page 5 in the brief filed May 13, 2005 averring the cited reference's failure to teach the method of delivery of the active as claimed are not convincing. Appellant's remarks with regard to Rouquet as only deliver the active on the surface of the skin are not convincing. The only active step recite is to applying the herein claimed composition onto the skin. Therefore, the applying of Rouquet's composition to the skin would inherently practice the recited step of "delivering the active into the skin, absent evidence to the contrary.

Appellant's arguments in page 5 in the brief filed May 13, 2005 averring the cited prior art's failure to teach the same properties as the herein claimed composition possessed are not convincing. Appellant's rebuttal arguments in page 5 in the brief averring Rouquet et al.'s failure to "distinguish between oil-soluble and water-soluble

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actives" are misplaced and flawed. Examiner notes that the basis of the outstanding rejection under 35 USC 102(b) is based on the fact that Rouquet et al. teaches the composition containing octyl methoxycinnamate, an oil-soluble anti-inflammatory agent.

Therefore, the composition of Rouquet is actually teaching an oil-soluble active.

Therefore, the alleged properties of the instant claimed composition is inherently present in the composition of Rouquet.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



San-ming Hui  
Primary Examiner  
Art Unit 1617

July 15, 2005

Conferees

  
SHAOJIA A. JIANG, PH.D.  
PRIMARY EXAMINER

THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
WINTON HILL TECHNICAL CENTER - BOX 161  
6110 CENTER HILL AVENUE  
CINCINNATI, OH 45224

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER